

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 4/10/09.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

3. Claims 19, 24-26, 35, and 36 remain rejected under 35 U.S.C. 102(b) as anticipated by Uetani et al. (U.S. Patent Application Publication 2001/0026905) as set forth in paragraph 3 of the office action mailed 1/16/09.
4. Claims 19, 24-26, 35, and 36 remain rejected under 35 U.S.C. 102(b) as anticipated by Teiichi et al. (WO 01/60938 with U.S. Patent Application Publication 2003/0069331 used as a translation) as set forth in paragraph 4 of the office action mailed 1/16/09.
5. Claims 19, 24-26, 35, and 36 remain rejected under 35 U.S.C. 102(b) as anticipated by LeBlanc (U.S. Patent 3,582,516) as set forth in paragraph 5 of the office action mailed 1/16/09.

#### ***Claim Rejections - 35 USC § 103***

6. Claims 15, 17-19, 24-26, 35 and 36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz (U.S. Patent 5,406,694) in view of LeBlanc or Teiichi as set forth in paragraph 6 of the office action mailed 1/16/09.
7. Claims 1, 5, 8-10, 13, and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz and LeBlanc or Teiichi as applied to claims 15-19, 24-26, 35 and 36

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above, and further in view of Tanaka et al. (U.S. Patent 4,376,194) as set forth in paragraph 7 of the office action mailed 1/16/09 with it begin further noted the ceramic chunk (40 of Figure 6) taught by Ruiz is used to form sliders for hard disk drive applications.

8. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz, LeBlanc or Teiichi, and Tanaka as applied to claims 1, 5, 8-10, and 12-14 above, and further in view of Schafer (U.S. Patent 5,421,884) as set forth in paragraph 8 of the office action mailed 1/16/09.

9. Claims 2-4 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ruiz and LeBlanc or Teiichi as applied to claims 15-19, 24-26, 35 and 36 above or Ruiz, LeBlanc or Teiichi, and Tanaka as applied to claims 1, 5, 8-10, and 12-14 above, and further in view of Brown (U.S. Patent 6,265,015) as set forth in paragraph 9 of the office action mailed 1/16/09.

### ***Response to Arguments***

10. Applicant's arguments filed 4/10/09 have been fully considered but they are not persuasive.

Applicants argue,

“According to Uetani, the quinonediazide compound is the radiation-sensitive ingredient and such compositions “utilize the fact that the quinonediazide compound, which is alkali-insoluble, is decomposed by the action of radiation to generate a carboxylic group, which makes the compound alkali-soluble.” As such, the quinonediazide compound is not only a required feature of Uetani’s composition but a material element as well.” and

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“In view of above, the adhesive action is a direct result of the curing process. Therefore, according to Teiichi, the curing agent is not only a required feature of Teiichi's composition but is a material element as well.” and

“As such, LeBlanc's resins require a haloepoxyalkane element to introduce the epoxy group into the novolac resin. In other words, LeBlanc teaches a composition that in addition to the novolac resin and solvent, includes additional materials which materially affect the basic and novel characteristics of the composition.” and

“Applicants submit that LeBlanc's composition, which requires the addition of a haloepoxyalkane and Teiichi's composition, which requires the addition of a curing agent, cannot be equated to the adhesive compositions of the present claims.”.

Independent claims 1, 15, and 19 each require an adhesive composition “consisting essentially of” a novolac resin and a solvent. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.”. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention (See MPEP 2111.03).

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It appears the basic and novel characteristics of applicants invention are to an adhesive composition including novolac resin and solvent for bonding two substrates. It also appears the basic and novel characteristics of applicants invention are unchanged by conventional components in so far as the components do not adversely affect the adhesive characteristics (Paragraph 0037). Applicants have not specifically shown the compositions of Uetani, Teiichi, or LeBlanc to have other than the basic and novel characteristics of applicants invention. The composition taught by Uetani does include a quinonediazide compound. However, there is nothing in Uetani that indicates the presence of this compound reduces the adhesive characteristics of the composition, and applicants have not shown that this compound would materially change the characteristics of applicants invention. The composition taught by Teiichi does include a curing agent. However, there is nothing in Teiichi that indicates the presence of this agent reduces the adhesive characteristics of the composition, and applicants have not shown that this agent would materially change the characteristics of applicants invention. The composition taught by LeBlanc does include an etherified novolac. However, the claims require a novolac resin and do not exclude any particular novolacs such as etherified novolac. It is additionally noted that although not required by the claims there is nothing in LeBlanc that indicates this novolac is reduced in adhesive characteristics as compared to any other novolac, and applicants have not shown that this particular novolac would materially change the characteristics of applicants invention as compared to any other novolac.

Finally, it is noted applicants do not claim the adhesive composition “consists of” a novolac resin and a solvent. This transitional phrase would exclude any element, step, or ingredient not specified in the claim.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571)272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/  
Primary Examiner, Art Unit 1791